



**UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
02/26/99	02/26/99	GEORGOPOULOS	K 10287/043001

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EXAMINER

WOITACH, J

ART UNIT

PAPER NUMBER

1632

DATE MAILED:

12/15/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/259,389

Applicant(s)
Georgopoulos et al.

Examiner
Joseph Weitach

Group Art Unit
1632



☐ Responsive to communication(s) filed on _____.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-17 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-17 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Election/Restriction

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-5, 10, 11, 13, 15, 16, drawn to nucleic acid, vector and cells, classified in class 536, subclass 23.1.
- II. Claims 6-9, 14-16, drawn to protein, classified in class 530, subclass 350.
- III. Claim 12, drawn to antibody, classified in class 530, subclass 539.
- IV. Claim 17, drawn to a transgenic animal, classified in class 800, subclass 8.

Claims 15, 16 are generic claims drawn to determination and treatment for either nucleic acid or protein, and will be examined to the extent that they encompass the elected subject matter with the election of group I or II.

Inventions I and II are independent and distinct, each from the other, because they possess characteristic differences in structure and function and each has an independent utility, that is distinct for each invention which can not be exchanged. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the invention of group I as claimed can be used to generate nucleic acid probes.

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Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

Inventions I and III are independent and distinct, each from the other, because they possess characteristic differences in structure and function and each has an independent utility, that is distinct for each invention which can not be exchanged. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the invention of group I as claimed can be used to generate nucleic acid probes.

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

Inventions II and III are independent and distinct, each from the other, because they possess characteristic differences in structure and function and each has an independent utility, that is distinct for each invention which can not be exchanged. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the invention of group II as claimed can be used as an antigen to generate antibodies.

Because these inventions are distinct for the reasons given above and the search required for Group II is not required for Group III, restriction for examination purposes as indicated is proper.

Inventions IV and I-III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different

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functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have not been disclosed to be used together. Because these inventions are distinct for the reasons given above and the search required for Group III is not required for Group I-II, IV restriction for examination purposes as indicated is proper.

The inventions above are independent and distinct, each from the other. They have acquired a separate status in the art as a separate subject for inventive effect and require independent searches. The search for each of the above invention is not co-extensive particularly with regard to the literature search. Further, a reference which would anticipate the invention of any one Group would not necessarily anticipate or make obvious any of the other groups.

For these reasons restriction for examination is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(h).

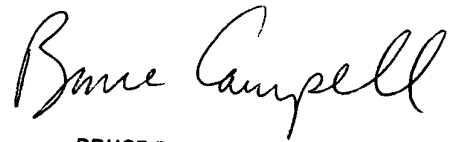
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph Woitach, whose telephone number is (703) 305-3732. The examiner can normally be reached on Monday through Friday from 8:00 to 4:30 (Eastern time).

If attempts to reach the examine by telephone are unsuccessful, the examiner's supervisor, Jasmine Chambers, can be reached on (703) 308-2035. The fax number for group 1600 is 1 (800)308-4242.

An inquiry of a general nature or relating to the status of the application should be directed to the group receptionist whose telephone number is (703) 308-0196.

Joseph T. Woitach


BRUCE R. CAMPELL
PRIMARY EXAMINER
GROUP 1800